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Date of Deposit: October 10, 2006

Our Case No. 10022/26

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Shawn S. Cornelius et al.)
Serial No. 09/710,155) Examiner: Jung, David Yiuk
Filing Date: November 9, 2000) Group Art Unit No. 2134
For ELECTRONIC SECURITY) Confirmation No. 4581
SYSTEM AND SCHEME FOR A)
COMMUNICATIONS NETWORK)

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Appellants request review of the Non-Final Office Action mailed July 10, 2006¹, in the above-identified application as to Claims 1-12, 14, 16-20 and 30-54. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets. No more than five (5) pages are provided. Claims 13, 15 and 21-29 have been cancelled and claims 55 and 56 have been withdrawn.

REMARKS

A. Devine et al.

1. Claims 1, 9-12, 30 and 31

Appellants traverse the rejection of claims 1, 9-12, 30 and 31 under 35 U.S.C. §103 as being obvious in view of Devine et al., U.S. Patent No. 6,606,708. In particular, independent

¹ While the Office Action was not made Final, the present Appeal is allowed under 37 CFR § 41.31(a) in view of the fact that the claims have been twice rejected.

claim 1 recites a second firewall having a nonnegative integer number of interconnections between a first set of ports and an internal communications network, “wherein the number of interconnections is dependent on a type of security mode.” It is noted that the Office Action fails to cite any portion of Devine et al. as disclosing the number of interconnections of a second firewall being dependent on a type of security mode.

In order to overcome the deficiencies of Devine et al., the Office Action has asserted that “[i]n software firewalls, the number of interconnections is always dependent on a type of security mode.” No reference is cited to support this assertion.² Without citing any art to support the assertion, it is unclear whether the Office Action is asserting that either 1) Devine et al. inherently or implicitly has a second firewall that has a number of interconnections dependent on a type of security mode or 2) having a second fire wall having interconnections dependent on a type of security mode is well known and it would have been obvious to alter Devine et al. to incorporate such interconnections. Assuming for argument’s sake that the Examiner is alleging inherency, then the extrinsic evidence must clearly establish that the descriptive matter missing from the reference is necessarily present in the embodiment described in the reference, and that it would be so recognized by one of ordinary skill in the art in order for inherency to be established. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1998). A reference implicitly discloses a matter when there are inferences in the reference that one skilled in the art would reasonably be expected to draw from the reference. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), MPEP § 2144.01. In the present case, the Office Action has not pointed to one passage of Devine et al. that would lead one of ordinary skill to infer or deem that Devine et al. inherently shows that the cited number of interconnections dependent on a type of security mode are necessarily present. Thus, the cited number of interconnections cannot be inferred or deemed inherently present in Devine et al.

Assuming for argument’s sake that the Examiner is alleging common knowledge, Appellants traverse the assertion that it is common knowledge that software firewalls have the

² Note that the undersigned requested copies of references to support the assertion from Supervisory Examiner Gilberto Barron, Jr. on October 2, 2006 and prior to September 6, 2006. None were supplied.

number of interconnections dependent on a type of security mode. It is not common knowledge. While it is always difficult to prove a negative premise, Appellants believe that it can be inferred from the prosecution history of the present application. In particular, there are ten references of record, including Devine et al., in the present application and yet the Examiner has not been able to show from any one of them (or from any other reference) that it is common knowledge that software firewalls have the number of interconnections dependent on a type of security mode. This failure is evidence that the references do not support the assertion. Accordingly, the Examiner is required to provide evidence that it is common knowledge pursuant to MPEP § 2144.03C. If no such evidence is provided, then the rejection should be withdrawn and the claims allowed.

2. Claims 3, 5, 17, 32-35, 39-43 and 49-51

Appellants traverse the rejection of claims 3, 5, 17, 32-35, 39-43 and 49-51 under 35 U.S.C. §103 as being obvious in view of Devine et al. In particular, independent claim 3 recites a “firewall blocks a transmission of an incoming data message through” the firewall “if the corresponding functions do not correspond to a function associated with processing the data message” and independent claims 5 and 17 each recites that a “firewall has the nonnegative integer number of interconnections only established for a limited duration on an as needed basis.” While the Office Action fails to cite any portion of Devine et al. as disclosing or suggesting the above mentioned firewalls, the Office Action has asserted “software firewalls [as recited in claim 3], such transmissions are always blocked in such circumstance” and the firewall of claims 5 and 17 “is what firewalls are supposed to do” (bracketed material added). If the Office Action is asserting that Devine et al. implicitly or inherently discloses the recited firewalls, the rejection is improper for reasons similar to those given above in Section A.1 for failing to cite any passage of Devine et al. that clearly shows that it has a firewall as recited in Appellants’ claims.

If the Office Action is asserting that the recited firewalls of claims 3, 5 and 17 are common knowledge, then Appellants traverse the assertion in that it is not common knowledge

as evidenced by the failure of the Office Action to point to any of the ten references of record as showing the recited firewalls. Accordingly, the Examiner is required to provide evidence that it is common knowledge pursuant to MPEP § 2144.03C. If no such evidence is provided, then the rejections should be withdrawn and the claims allowed.

3. Claims 2, 4, 8, 14, 16, 20 and 36-38

Appellants traverse the rejection of claims 2, 4, 8, 14, 16, 20 and 36-38 under 35 U.S.C. §103 as being obvious in view of Devine et al. Appellants traverse the rejection. In particular, independent claims 4 and 16 each recites a firewall including “a quaternary interconnection for monitoring operations and maintenance of the internal resource affiliated with the internal communications network.” The Office Action fails to cite any passage in Devine et al. as disclosing the claimed quaternary interconnection. If the Office Action is asserting that Devine et al. implicitly or inherently discloses the recited firewall, the rejection is improper for reasons similar to those given above in Section A.1 for failing to cite one passage of Devine et al. that clearly shows that it has a firewall that includes a quaternary interconnection for monitoring operations and maintenance of the internal resource affiliated with the internal communications network.

The Office Action has asserted that for “software firewalls, such monitoring [by a quaternary interconnection] is always done so as to protect such internal resource in such fashion” (bracketed material added). If the Office Action is asserting that the recited firewall is common knowledge, then Appellants traverse the assertion in that it is not common knowledge as evidenced by the failure of the Office Action to point to any of the ten references of record as showing the recited firewall with a quaternary interconnection. Accordingly, the Examiner is required to provide evidence that it is common knowledge pursuant to MPEP § 2144.03C. If no such evidence is provided, then the rejections should be withdrawn and the claims allowed.

4. Claims 7, 19, 44-48 and 52-54

Appellants traverse the rejection of claims 7, 19, 44-48 and 52-54 under 35 U.S.C. §103 as being obvious in view of Devine et al. In particular, independent claims 7 and 19 each recites

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that a first port identifier of one firewall is different from “one or more second port identifiers for each active interconnection.” The Office Action fails to cite any portion of Devine et al. as disclosing or suggesting the above mentioned relationship. The Office Action has also failed to assert that the relationship is common knowledge. Accordingly, the rejection is improper and should be withdrawn.

B. Devine et al. and Lucent LMF Reference

Appellants traverse the rejection of claim 6 and 18 under 35 U.S.C. §103 as being obvious in view of Devine et al. and the article entitled “A Technical Overview of the Lucent Managed Firewall” (hereinafter “the Lucent LMF reference”). Since the Lucent LMF reference does not suggest altering Devine et al. to use either 1) a second firewall “wherein the number of interconnections is dependent on a type of security mode” as recited in claim 1 from which claim 6 depends or 2) a firewall including “a quaternary interconnection for monitoring operations and maintenance of the internal resource affiliated with the internal communications network” as recited in claim 16, the rejection is improper and should be withdrawn.

In summary, the Examiner has clearly failed to meet his burden to establish a *prima facie* case of unpatentability of the pending claims in the present Office Action. Accordingly, the rejections should be withdrawn and the claims allowed.

Respectfully submitted,



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